United States Court of Appeals

for the Second Circuit

BRIEF FOR APPELLANT

76-7563

United States Court of Appeals

FOR THE SECOND CIRCUIT

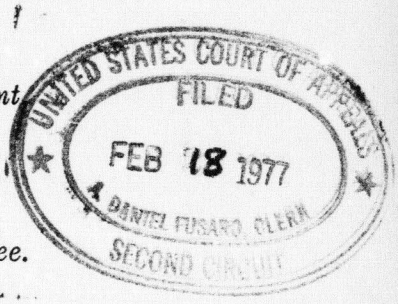
DAVID COHN,

Plaintiff-Appellant

against

COLECO INDUSTRIES, INC.,

Defendant-Appellee.



APPEAL FROM AN ORDER AND JUDGMENT OF THE UNITED STATES DISTRICT COURT FOR THE SOUTHERN DISTRICT OF NEW YORK

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P/S

BRIEF FOR PLAINTIFF-APPELLANT

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Dated: February 10, 1977
At: New York, New York

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I. PRELIMINARY STATEMENT

This is an appeal under 28 U.S.C. 1291 from the final Order and Summary Judgment of the Honorable Whitman Knapp, United States District Judge for the Southern District of New York. The hearing on the Defendant-Appellee's Motion for Summary Judgment (Appendix at 18) was held on June 11, 1976. The final Order and Judgment were entered on October 12, 1976 (Appendix at 253). Neither the District Court's decision nor the final Order and Judgment have been reported in any publication.

II. STATEMENT OF THE ISSUE PRESENTED FOR REVIEW

Is there a genuine issue as to any material fact?

III. STATEMENT OF THE CASE

This patent infringement action was commenced on May 1, 1975 by appellant (plaintiff below), David Cohn (hereinafter Cohn"), patentee, against appellee (defendant below), Coleco Industries, Inc. (hereinafter "Coleco"), seeking a judgment, inter alia, that:

(1) Coleco be enjoined from infringing upon Cohn's U. S. Letters Patent 3,019,020 for a toy bowling game.

(2) Coleco be required to account to Cohn for all profits realized by Coleco and damages suffered by Cohn resulting from the infringement and that the damages be trebled. (Appendix at 4)

Coleco filed its Answer and Counterclaim on May 23, 1975 (Appendix at 7). The Answer denied any infringment of the Cohn Patent by the toy bowling game that Coleco is selling. In the Counterclaim, Coleco countersued for declaratory judgment of invalidity of the Cohn Patent under 28 U.S.C. 2201 on several grounds. Coleco also sought dismissal of the Complaint and injunctive relief against Cohn's enforcement of his Patent against Coleco.

In his Reply filed June 6, 1975, Cohn denied the allegations of invalidity made in Coleco's Counterclaim.

Coleco filed a Notice of Motion and Motion for Summary Judgment of Non-Infringement of the Cohn Patent based on the doctrine of file wrapper estoppel (Appendix at 18, supporting documents at 20 to 182). Cohn filed a Memorandum and supporting documents in opposition to the Coleco Motion (Appendix at 183 to 250, Memorandum at 208). The hearing on the Motion was held before Judge Whitman Knapp on June 11, 1976; and in his Memorandum and Order No. 44939 (Appendix at 251), the Court granted Coleco's Motion based on Pittway Corp. v. Trine Mfg. Corp. (S.D.N.Y. 1974) 183 U.S.P.Q. 675. The Judgment dismissing the action on the merits was entered on October 12, 1976 (Appendix at 253).

IV. STATEMENT OF THE FACTS

COHN'S U.S. PATENT 3,019,020

Cohn invented the first unitary toy bowling game with play action simulating regulation bowling, automatic removal of struck bowling pins from the playing surface, and a single reciprocating action for resetting of the bowling pins, using a stationary guide plate to properly locate the pins on the playing surface.

With the exception of the bowling ball, Cohn's invention is a unitary device, i.e., the playing surface, bowling pins and reset means are a unit. Despite the fact that Cohn's invention is a toy and not a regulation or intermediate size game, it nevertheless simulates the action of a regulation size game, e.g., a struck pin is free to strike a neighboring pin. Struck pins are automatically removed from the playing surface as they also are in regulation bowling games. All struck pins may be reset by a single reciprocating action.

Cohn's invention comprises a playing base comprised of magnetic material, bowling pins containing magnets which are attracted to the magnetic material of the playing base, elastic ligaments attached to the tops of the bowling pins, the other ends of the elastic ligaments being passed through holes in a triangular configuration in a guide plate fixed above the base, and then the ends of the elastic ligaments are attached to a vertically spring urged reciprocatable reset means. In one of its reciprocating positions, the

reset means allows the bowling pins to make contact with the magnetic material of the playing base and to be attracted to it. In the other reciprocating position, the elastic ligament is stretched or placed under tension. The tension is not sufficient to break the magnetic attraction of the bowling pins to the base, but is sufficient to pull bowling pins up from the base when the pins are struck by the ball.

Appellant David Cohn, now retired, sold large quantities of the bowling game of his invention while he was a toy manufacturer and his company was still in business. Appellee Coleco Industries, Inc. is believed to have been highly successful in selling its essentially similar BOWL-A-MATIC games, advertising them heavily on television.

COLECO'S INFRINGING TOY BOWLING GAME

A discussion of the Coleco toy bowling game would be repetitive of the discussion of Cohn's invention presented above because the games are essentially the same.

Further analysis of Coleco's infringing BOWL-A-MATIC 300 game is presented in the affidavit of Mr. William R. Slinger (Appendix at 183) which was submitted with the Memorandum in Opposition to the Motion for Summary Judgment (Appendix at 208). Mr. Slinger is a Mechanical Engineer, has worked in a variety of mechanical engineering positions, including positions as a Design Engineer. The game which Mr. Slinger inspected is a BOWL-A-MATIC 300 game which had been slightly modified so as to demonstrate the fact that

Coleco's toy bowling game is a colorable imitation of Cohn's invention which is the subject of the patent in suit. (Photographs of the game (18 Figures) are in the Appendix as Cohn's Exhibit B at 190).

Mr. Slinger's affidavit demonstrates that Coleco's BOWL-A-MATIC 300 game has substantially the same structure, mode of operation, and result as the invention which is the subject of the Cohn patent in suit.

Mr. Slinger's Affidavit controverts the statements made in the Affidavit made on behalf of Coleco's Motion for Summary Judgment by Dr. David Wetstone (Appendix at 174). Whatever competence Dr. Wetstone may have as a Chemist, no credentials are set forth in his Affidavit which qualify the gentleman to give credible, competent evidence as to mechanical devices such as those which form the subject matter of this action.

Mr. Richard Freeman, listed as inventor of the Coleco-Freeman U.S. Patent No. 3,866,691 covering the Coleco toy bowling game and a Product Manager employed by Coleco, has stated that the BOWL-A-MATIC game is reset with a reciprocating action, which also moves the spring bar in an up-down reciprocating action. (Cohn's Exhibit C - Appendix, 217.) The string from the spring bar (also called "spring support brace") to the reset handle at the front of the game is not necessary but is a marketing point for consumer convenience (Appendix, 218). "It is possible to dispense with the handle (80) and string (50) (Appendix, 219-221). This is

demonstrated in Mr. Slinger's Affidavit and in Exhibit B photographs mentioned above. Mr. Slinger found a literal or functional equivalent for each essential element in the claims of the Cohn patent. Also in point are Cohn's answers to interrogatories 16 and 17 and Coleco's Exhibit H (Appendix at pages 125 -129 and 158 - 160 respectively), which show the correspondence of the essential elements of the Cohn patent to the Instruction sheet of the infringing Coleco game and to their improvement Patent 3,866,691.

In the exchange from pages 59 to 64 of Exhibit C (Appendix, 222 -227), Mr. Freeman agreed with the dictionary definition of "integral" as applied to the side panels 74 and 76 and playing surface 16 of the BOWL-A-MATIC games. In a rigorous exchange from pages 64 to 67 of Exhibit C (Appendix, 226-229), the same dictionary's definition of "flange" was presented by Plaintiff's Counsel, Kenneth E. Macklin, to Defendant's Counsel, Peter L. Costas, but he objected to that appellation for the parts of the side panels (74) and(76) which project above the playing surface (16).

V. ARGUMENT

A. Summary

Briefly, Cohn contends that:

(1) There are genuine issues of material fact.

(2) Summary judgment is therefore not applicable.

(3) File wrapper estoppel has not been established

and the proper consideration of the question will require a trial and testimony.

(4) The doctrine of equivalents is available to bring Coleco's product within the scope of the Cohn Patent 3,019,020.

(5) Coleco's toy bowling game is a colorable imitation and therefore an infringing product.

(6) Coleco's Freeman Patent is not relevant.

The Motion for Summary Judgment raised the issues of the doctrine of equivalents and the doctrine of file wrapper estoppel. Those issues are issues of fact; and summary judgment should not be granted disposing of such issues, if there is a genuine issue of material fact.

The Court below based its decision to grant summary judgment on Pittway Corp. v. Trine Mfg. Corp. (S.D.N.Y. 1974) 183 U.S.P.Q. 675. The case was decided on its own unique set of facts which are not analogous to those in this case.

Cohn's Patent 3,019,020 was amended inter alia so that it would not include within its claims the prior art cited by the Examiner. It is well settled that claims so amended are nevertheless entitled to a range of equivalents. To hold or argue otherwise would render a patent valueless to a patentee. For to find infringement, every literal "nut" and "bolt" would have to be found in an infringing device. What Cohn disclaimed were the prior art patents and not the Coleco infringing devices. Neither does Coleco state that

its infringing games are within the ambit of the prior art patents disclaimed by Cohn.

A comparison of the two games (Cohn's and Coleco's) by Cohn's expert, William Slinger, led him to the conclusion that the Coleco game and the Cohn game are essentially similar, but that Coleco "had hung pineapples on Cohn's game" in Mr. Slinger's colorful expression. There is much that Mr. Slinger can add in the way of testimony to expand on the points raised in his affidavit. This will be possible at trial, but was unfortunately not available to the Court below. If he had been able to explain the technology in person for the Court, he would have been able to give expert testimony concerning the Coleco BOWL-A-MATIC game to properly compare in a demonstrative way the correspondence of the elements and the directions of the vectors which are affected by the contorted three 90 degree turns that the game requires for its reset of pins and show that it is exactly the same in result as if the reset string were severed and the spring support brace manipulated more in the fashion illustrated in the Cohn Patent.

In contrast Dr. Wetstone with a Ph.D. in chemistry has not been qualified as an expert in a relevant area of mechanical engineering, whatever his qualification may be as a Chemist.

In Moore Business Forms, Inc. v. Minnesota Mining and Manufacturing Co., 52 1 F. 2d 1178 (1975), this Court stated that

"Moreover, courts should be cautious in granting summary judgment on the issue of equivalence, especially where, as here the prior art with respect to the invention asserted is not fully developed in the record and not readily understandable without expert testimony. Id. 1185.

In teh same case, this Court stated the burden on a defendant seeking summary judgment in a patent infringement suit:

"3M, as the moving party, has the burden of showing an absence of any material factual issue requiring a trial." Id. 1185.

Coleco takes issue with six points: those which are mentioned on pages 9 and 10 of their Memorandum in Support of the Motion for Summary Judgment (Appendix, 28-29). The Court below did not specify in its Memorandum and Order what the "certain ... structural limitations" in the amended claims of the Cohn patent are that are not present in the Coleco game. However, even the Pittway case states that for file wrapper estoppel to enter into action there must have been an amendment to overcome prior art.

Reviewing the six points of Coleco, it will be noted that the first one, the base plate, was present in the original claim 4 filed with the application. (See Appendix, 50.) Therefore, there is no file wrapper estoppel possible in connection with that claimed element. Point two was discussed above in the last paragraph of Section IV of this Brief.

Points three to six are again shown in Exhibit H (Appendix, 158). Point three finds its corresponding Coleco game part in those generally vertical parts 34 and 36 of the left center drawing in combination with part 40 which is generally horizontal across the upper sections of the two former parts, thereby forming an inverted "U". The part 40 receives the guide plate 118, similar to the part 16 on the top of part 13 of the Cohn Patent.

Point four may be seen in the photographs, e.g., those at pages 196 and 197 of the Appendix. The supporting member is the white horizontal bar to which the springs are attached. Point five may be seen from those same photographs, e.g., the extreme left and right springs attached to the white bar and intermediate the guide plate (with the conical protrusions). It appears from the photographs that the springs are urging the support member in an upward direction, i.e., away from the base.

Point six is seen in the same photgraphs in the combination of the string and the spring attached to the spring bar or supporting member and at the other end of the string to the pins as seen in photographs at pages 193 to 195 of the Appendix.

Whether there is used a string made entirely of elastic or a combination of a spring and a string, the functioning of the game is exactly the same whether one or the other is used as seen in the photographs at pages 196 and 197. The first three pins have strings made entirely from elastic.

The other seven pins have the elasticity imparted to the string by a segment of spring. The elastic ligaments function the same in either case. See the Affidavit by William Slinger at page 183 of the Appendix for a detailed description of all the photographs and particularly his conclusions on page 188, wherein he finds no functional differences whether the elastic ligaments are made entirely of elastic or whether the elasticity is imparted to the string by a segment of spring. Mr. Slinger also found no functional difference whether the there are magnets in the base or the magnetic material mentioned in the Cohn Patent is sheet steel. He also found no functional difference whether there was used the Coleco reset handle or whether the bends were taken out of the control string leading to the reset handle and the the alternative reset mechanism illustrated in the Cohn Patent was used. Attention is respectfully directed to the next to last paragraph of Section IV above concerning the transcript of the deposition of Mr. Freeman on the direction of the reset force not being necessary to the Coleco game.

Coleco makes much of the Lloyd (U.S. Pat. No. 2,217,063) and Igou (U.S. Pat. No. 1,913,673) patents (Appendix, 130 and 137 respectively) and the amendments which were offered by Cohn's Counsel in reply to multifaceted Official Actions from the Patent Office. Lloyd shows a vertically movable locator plate 28 into which the struck pins are retracted. (Cohn's guide plate is stationary.) In the Lloyd game, to

reset the pins on the alley, one has to unlatch the tops of the two side mounted spring steel stanchions 27 holding the movable locator plate and manually slide the locator plate holding the pins down until the pins make contact with the alley. The spring steel stanchions exert lateral pressure on the locator plate. It appears that the game described and depicted is bigger than toy size. Igou shows free standing pins which must be manually picked up in single fashion and singly placed in the pin holder or template 17. This is spring counterweighted and the whole pin holder with all pins contained in it is moved to reset the pins. It too appears to be a game much larger than a toy.

Size makes for a difference in kind rather than degree because of the weight of the pins, their momentum when struck, and the construction of the reset means required because of the weight of the pins. Conversely, the light weight of the pins in a toy bowling game presents problems to be overcome in order to simulate regulation size bowling which uses heavy pins.

It can be seen then that the games of the Lloyd and Igou references are in a separate and distinct class from the Cohn and Coleco toy bowling games.

The leading case on the doctrine of equivalents is, of course, Graver Tank & Manufacturing Co. v. Linde Air Products Co., 339 U.S. 605 (1950). As stated therein:

> "The essence of the doctrine is that one may not practice a fraud on a patent *** 'To temper unsparing

> logic and prevent an infringer from stealing the benefit of the invention' a patentee may invoke this doctrine to proceed against the producer of a device 'if it performs substantially the same function in substantially the same way to obtain the same result.'" Id. at 608.

Athough the patent at issue in Graver was found to be a "pioneer patent," the Court made clear that the doctrine did not per se turn on such a finding although narrower patents are generally afforded a lesser range of equivalents.

The equivalents doctrine is a question of fact, and the Cohn patent in suit is entitled to its range of equivalents. It is important to note that this is not a case where specific Coleco means were excluded from the claims. Rather, certain amendments were submitted to avoid having the claims read on means unlike Coleco's. There is certainly no estoppel with respect to the specific amendments in question.

Coleco's game is more similar to Cohn's patent than to the prior art devices of Lloyd and Igou. As stated in Southern Textile Machinery Co. v. United Hosiery Mills Corp. 33 F. 2d 862, 866 (6th Cir. 1929):

> "This doctrine (of file wrapper estoppel) does not, however, go to the extent of depriving a patentee of protection against all equivalents and the doctrine may be subject to abuse when applied to the rejection

> upon reference of broad generic claims where narrower claims are allowed which would fully protect the patentee if permitted but a narrow range of equivalents. Under such circumstance, the patentee may reasonably be content with the claim allowed if he be afforded a fair construction and the protection against obvious and exact equivalents; and the estoppel should go no further than to bar the patentee from reliance upon the cancelled claim in its broadest or generic construction.

See also, Tektronix, Inc. v. United States, 445 F. 2d 323,328 (Ct.Cl. 1971); Eastern Rotorcraft Corp. v. United States, 397 F 2d 978,981-82 (Ct.Cl. 1968); Dole Valve Co. v. Perfection Bar Equipment, Inc., 298 F. Supp. 401, 406 (N.D. Ill. 1968), aff'd, 419 F. 2d 968 (7th Cir. 1969); Tensitron, Inc. v. Bromley, 260 F. Supp. 457, 459 (E.D.N.Y.), aff'd, 369 F. 2d 699 (2nd Cir. 1966); Warner and Swasey Co. v. Held, 256 F. Supp. 303,309 (E.D. Wis. 1966).

On the matter of file wrapper estoppel, Ziegler v Philips Petroleum Co., 483 F. 2d 858 (1973) is of interest. As stated therein:

> "The mere surrender or amendment of a claim in the Patent Office does not, however, bar a patentee from asserting the doctrine of equivalents. He is

estopped only from reclaiming what he surrendered. *** Hence it is necessary to determine what in fact the patentee gave up in order to receive its patent, see Edward Valves, Inc. v. Cameron Iron Works, Inc., supra, and what is the essence of the invention that remains. *** Moreover, an applicant should not be presumed to have made a disclaimer broader than necessary to yield to the actual challenge to his claim." *** Id. at 870.

On the matter of improvements, the Court in the Ziegler case had this to say:

"An improver cannot appropriate the basic patent of another, and an unlicensed improver is an infringer.

***

"Correlatively, the grant of a patent on an improvement of a patented article does not excuse infringement of the dominant patent. *** Therefore, one who appropriates the substance of a patented invention without the consent of the patentee does not escape infringement by improving upon or subtracting from the invention so long as the essential elements are retained." Id. at 871.

Cohn made his invention in a different era in the toy business, what might be called the tinplate era. Today Coleco is operating in the plastic era. When he manufactured the toy bowling games which he sold, Mr. Cohn used a sheet

metal construction as depicted in the Cohn Patent in suit. Today Coleco manufactures the bowling game from plastic and other less durable materials. At the time of his invention, sheet metal fabrication was what might be considered the best mode of manufacturing. The Ziegler case states:

> "Under 35 U.S.C.A. 271, a patentee's rights are infringed by anyone who 'makes, uses or sells" the claimed invention. Moreover, the patentee need not spell out in the patent claims each of the many possible examples of the making and using of his invention. Section 112 of the Patent Code, 35 U.S.C.A. 112, merely requires the patentee 'to set forth the best mode contemplated *** of carrying out his invention. 'And normally the claims of a patent will not be restricted to such a 'best mode.'" Id. at 871.

In summary, Cohn has indicated in this Brief together with its associated documents that a good number of material issues of fact are present in this action. In view of these outstanding issues of fact and the demonstrated essential similarity of the Coleco games to those covered in Cohn's patent rather than to the prior art patents cited, Cohn respectfully submits that the summary judgment of non-infringement should be reversed.

VI. CONCLUSION

On reason and authority, the final Order and Summary Judgment of the District Court should be reversed by ordering that the Complaint be reinstated and that the case be remanded for trial on the merits.

Respectfully submitted,

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